

REMARKS

Applicants concurrently file herewith an Excess Claim Fee Payment Letter, and corresponding excess claim fee, for one (1) excess independent claim.

Claims 1, 4-14, 20 and 21 are all the claims presently pending in the application.

Claims 1, 4-6 and 8-14 have been amended to more particularly define the invention. Claim 3 has been canceled without prejudice or disclaimer. Claim 21 has been added to provide more varied protection for the claimed invention.

Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

The Amendment filed on December 9, 2004 is objected to under 35 U.S.C. §132(a) because it allegedly introduces new matter into the disclosure. Claims 1 and 3-14 stand rejected under 35 U.S.C. §112, second paragraph, as indefinite. Claims 8-10 and 13 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Claims 1, 5-8, 12 and 14 stand rejected under 35 U.S.C. §102(b) as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as being unpatentable over, Onuma, et al. (U.S. Patent No. 5,605,778) (hereinafter “Onuma”), as evidenced by Shaffert (“Electrophotography”, John Wiley & Sons, New York, 1975, page 604) (hereinafter “Schaffert”). Claim 4 stands rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Onuma. Claim 5 stands rejected under 35 U.S.C. §102(b) as being anticipated by Ohno (U.S. Patent No. 6,447,968).

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention of exemplary claim 1 provides an electrostatic charge image developing toner wherein at least one of the wax components includes a crystallinity which is greater than 85% and less than 93%. This feature is important for providing a toner capable of achieving stable printing with limited variation due to the printing environment (see Application at page 7, line 24 through page 8, line 1).

II. NEW MATTER OBJECTION

The Examiner has objected to the Amendment filed on December 9, 2004 under 35 U.S.C. 132(a) for introducing new matter into the disclosure. The Examiner, however, is clearly incorrect.

That is, in the Examiner's Office Action dated September 22, 2004, the Examiner objected to the Specification because "In example 1, the sum of the amounts of the components in the toner, i.e., 85 wt% for binder resin, 1 wt% for charge control agent, 10 wt% for carbon black, 4.25 wt% for polyethylene wax, and 0.75 wt% for paraffin wax, is 101 wt%. It is not clear how the sum of weight percentages based on the total weight of the toner can be other than 100 wt%" (see Office Action dated September 22, 2004 at page 2). In the Amendment filed on December 9, 2004 Applicants amended the Specification to recite 84 wt % of binder resin to correct an apparent typographical error.

Applicants submit that it would have been apparent to one of ordinary skill in the art that Applicants merely amended the specification to correct a typographical error and did not add new matter to the Specification.

III. THE 35 USC §112, SECOND PARAGRAPH, REJECTION

Claims 1 and 3-14 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have amended claims 1 and 5 to more clearly define the claimed invention.

Specifically, Applicants have deleted the phrase “a rationalized molecular weight distribution by including” from each of claims 1 and 5.

Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

IV. THE 35 USC §112, FIRST PARAGRAPH, REJECTION

Claims 8-10 and 13 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Applicants have amended claim 13, in accordance with the Examiner’s rejection.

However, regarding the Examiner’s rejection of claims 8-10 and 13, the Application clearly states that “In the present invention, the wax can be obtained from the natural wax or the synthetic wax. There are animal/plant wax, mineral wax and petroleum wax as the natural wax. There are Fischer-Tropsch wax, polyethylene wax, etc. as synthetic wax” (see Application at page 15, lines 19-23). Indeed, the Examiner even points out the support for the terms “natural wax or synthetic wax” in her rejection (see Office Action dated July 28, 2006 at page 9).

The Examiner alleges that Examples 1 and 2 of the Application do not provide support for the limitations of claims 8-10. However, Applicants submit that Examples 1 and 2 are merely non-limiting examples of certain exemplary embodiments of the invention. Indeed,

the Application clearly states that "Examples of the present invention will be explained hereinafter, but the present invention is not limited to these examples" (see Application at page 29, lines 1-3).

Applicants point out that "To satisfy the written description requirement, a patent specification must describe the invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention" (see M.P.E.P. §2163). The Applicant must show that (1) he was in possession, (2) of the invention, (3) at the time the application was filed.

Applicants submit that the written description has been met, because one of ordinary skill in the art, in view of the original disclosure at page 15, lines 19-23, would reasonably conclude that the inventor had possession of the claimed invention at the time the Application was filed. Thus, Applicants have provided clear support in the Specification (as indicated above) for the limitations of claims 8-10.

Furthermore, Applicants submit that one of ordinary skill in the art would clearly understand that Applicants did not intend to limit themselves to the features provided in Examples 1 and 2.

Finally, regarding claims 8-13 the Examiner clearly has not properly understood the claim language recited therein. With respect to claims 8-13 the Examiner alleges that the claims require all of the recited components to be included. The Examiner, however, is clearly incorrect.

That is, claims 8-13 clearly recite "one of..", which indicates that only one of the recited components is included. However, merely in an effort to speed prosecution, Applicants have amended each of claims 8-13 to recite an alternative expression using the term "or".

V. THE PRIOR ART REFERENCES

A. The Onuma Reference

The Examiner alleges that Onuma (as evidenced by Schaffert) teaches (or makes obvious) the claimed invention of claims 1, 5-8, 12 and 14. Furthermore, the Examiner alleges that the invention of claim 4 is anticipated, or in the alternative, would have been obvious in view of Onuma. Applicants submit, however, that there are elements of the claimed invention, which are neither taught nor suggested by (nor made obvious in view of) Onuma, taken alone or in view of Schaffert.

That is, Onuma (taken alone or in view of Schaffert) does not teach or suggest an electrostatic charge image developing toner “*wherein at least one of said wax components comprises a crystallinity which is greater than 85% and less than 93%*”, as recited in claim 1.

Indeed, the Examiner concedes that “Onuma does not teach or suggest that one of the wax components has a crystallinity of greater than 85% and less than 93%” (see Office Action dated July 28, 2006 at pages 21-22).

Moreover, Onuma (taken alone or in view of Schaffert) does not teach or suggest an electrostatic charge image developing toner “*wherein said wax comprises an appropriate amount of a low molecular weight wax component in said wax to maintain sufficient fixing performance while maintaining heat resistance and durability*”, as recited in claim 5.

Indeed, the Examiner attempts to rely on Table 2, example 9 as well as several passages of the disclosure of Onuma to support her allegations. However, Applicants submit that the Examiner is clearly incorrect.

That is, nowhere, in these passages (nor anywhere else for that matter) does Onuma teach or suggest an electrostatic charge image developing toner wherein the wax includes an

appropriate amount of a low molecular weight wax component in the wax to maintain sufficient fixing performance while maintaining heat resistance and durability. Indeed, the Examiner does not even allege that Onuma teaches or suggests this feature.

The Examiner alleges that “Onuma shows that the toner comprising its particular combination of waxes provides toner images that have excellent low-temperature fixability and anti-offset characteristic” (see Office Action dated July 28, 2006 at pages 15-16). However, as detailed in the Application, certain conventional toners have been developed, similar to that of Onuma, that produce an effect of preventing low-temperature offset and the improvement of low-temperature fixing by increasing an amount of certain components in its combination of wax components (see Application at page 10, lines 9-17).

However, Applicants have discovered that if low molecular weight components are increased to improve the fixing performance, the heat resistance and the durability are lowered and thus fusion of the developer into the carrier may be caused (see Application at page 10, lines 18-21). Accordingly, the claimed invention provides an electrostatic charge image developing toner wherein the wax includes an appropriate amount of a low molecular weight wax component in the wax to maintain sufficient fixing performance while maintaining heat resistance and durability. This feature is not taught or suggested by Onuma.

That is, while Onuma may provide a toner having excellent low-temperature fixability and anti-offset characteristic, Onuma does not provide a toner that also maintains sufficient fixing performance while maintaining heat resistance and durability, as in the claimed invention.

Therefore, Applicants submit that there are elements of the claimed invention that are not taught or suggested (nor made obvious) by Onuma as evidenced by Schaffert. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

B. The Ohno Reference

The Examiner alleges that Ohno teaches the claimed invention of claim 5. Applicants submit, however, that there are elements of the claimed invention, which are neither taught nor suggested by Ohno.

That is, Ohno does not teach or suggest an electrostatic charge image developing toner “*wherein said wax comprises an appropriate amount of a low molecular weight wax component in said wax to maintain sufficient fixing performance while maintaining heat resistance and durability*”, as recited in claim 5.

Indeed, the Examiner attempts to rely on example 9, Figure 1 and column 35, line 55 through column 36, line 11 of Ohno to support her allegations. However, Applicants submit that the Examiner is clearly incorrect.

That is, nowhere, in these passages nor this figure (nor anywhere else for that matter) does Ohno teach or suggest an electrostatic charge image developing toner wherein the wax includes an appropriate amount of a low molecular weight wax component in the wax to maintain sufficient fixing performance while maintaining heat resistance and durability. Indeed, the Examiner does not even allege that Ohno teaches or suggests this feature.

The Examiner merely alleges that claim 5 does not positively recite that the apparatus comprises the particular toner.

However, claim 5 has been amended to positively recite this feature.

Therefore, Applicants submit that there are elements of the claimed invention that are not taught or suggested (nor made obvious) by Ohno. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

VI. NEW CLAIM

New claim 21 has been added to provide more varied protection for the claimed invention. This claim is patentable over any combination of the cited prior art references because of the novel and non-obvious features recited therein.

Applicants submit that claim 21 is patentable over any combination of the cited prior art references at least for analogous reasons to those set forth above with respect to claims 1, 4-14 and 20.

VII. FORMAL MATTERS AND CONCLUSION

In accordance with the Examiner's objection to the claims, Applicants have corrected an editorial error in claim 20 by deleting the term "and."

In view of the foregoing, Applicant submits that claims 1, 4-14, 20 and 21, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

Serial No. 10/662,340
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The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

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